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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,909	01/10/2001	Steven W. Arms	1024-035	8315
26542	7590	04/09/2004	EXAMINER	
JAMES MARC LEAS 37 BUTLER DRIVE S. BURLINGTON, VT 05403			TUGBANG, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/757,909

Applicant(s)

ARMS ET AL.

Examiner

A. Dexter Tugbang

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

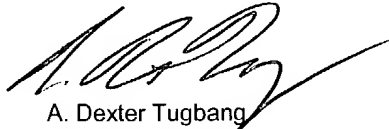
NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: 87-91.Claim(s) rejected: 1-3, 27-32, 74-100, 102 and 103.Claim(s) withdrawn from consideration: 4-26, 72, 73 and 101.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


A. Dexter Tugbang
Primary Examiner
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Attachment to Advisory Action

The examiner notes that in the After Final amendment filed 3/15/04, the claims under prosecution and listed by the applicants' have not been amended and are the same as presented in the amendment filed 10/20/03.

In regards to the merits of Person et al, the applicants' contend that Person does not teach: 1) dicing completely through the coil; 2) a movable core; 3) a tube outer surface; and 4) the order of steps, particularly the order of steps a, b and c in each of Claims 102 and 103.

The examiner most respectfully disagrees for the following reasons.

I. Dicing

The examiner's position is that the cut marks 112 and 114 of Person are considered to be "dicing completely through said coil" (as required by Claim 1). Prior to cutting, the pattern of conductive lines *in their entirety* (as shown in, for example, Fig. 3I) is considered to be one coil pattern. The act of cutting at the cut marks contributes to the *final shape of the conductive lines*, to produce another coil pattern, i.e. coil. Thus, Person fully satisfies the limitations of "dicing completely through said coil".

II. Movable Core

The examiner has carefully considered the limitations directed to "a movable core". It is noted that the claims do not recite to what degree the core must be movable or do not recite to what degree that the core must be movable with respect to the claimed "tube". The fact that the tube of Person is read as, for example, termination cap 12, and the tube 12 is mounted or moved over the core (see col. 3, lines 46-48), the core can be said to be a "movable core" with respect to the tube. It appears that further limitations are needed as to how the core being movable adjusts

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the inductance, or at least further limitations more specific than the functional language of “for adjusting inductance of said coil” (as recited in each of Claims 75 and 103).

III. Tube Outer Surface

The applicants’ assert that the claimed “tube outer surface” is distinguished from the inner surface of the tube. The examiner maintains that any surface of the tube can be read as the “tube outer surface” since the claims do not recite any other surface, particularly, any tube inner surface. The examiner fails to understand how the “tube outer surface” can be distinguished for the “tube inner surface” when the claims do not even recite any “tube inner surface”. It appears that the applicants’ are arguing more specifically than that which is claimed. Being that any surface of tube 12 can be read as the claimed “tube outer surface”, the core of Person can be said to be on the tube outer surface.

IV. Order of Steps

The applicants’ assert that the preamble of the claims require a specific order of steps and the examiner has carefully considered, and given patentable weight, to the order recited in the preamble of Claims 102 and 103. The applicants’ believe that steps a, b and c are not taught in that order by Person because the openings of formed after the coil is provided. For further clarification, the examiner notes the sequence of Figures 3C-3J of Person, with a particular emphasis on Figures 3E and 3F. The multiple layers 72 are read as the “insulation” in which openings 39, 49 are formed. Figure 3E shows the coils being formed and then *subsequently*, the openings 39, 49 in Figure 3F are formed over the coils. Thus, step b occurs *after* step a, and the order of steps of a, b and c are fully satisfied by Person in each of Claims 102 and 103.

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In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).